

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated September 9, 2004, indicated that the amendment filed 22 July 2001 is objected to under 35 U.S.C. § 132; claims 1-12 and 14-19 stand rejected under 35 U.S.C. § 112, first paragraph; claims 1-12 and 17-19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Yang* (USPN 6,113,462); and claims 14-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Yang* (USPN 6,133,462) in view of *Hu et al.* (USPN 6,227,947).

Applicant respectfully traverses the objection under 35 U.S.C. § 132 because the Office Action's reference to an amendment filed 22 July 2001 is unclear; no amendment was filed on 22 July 2001. Applicant requests clarification and an opportunity to respond thereto.

Notwithstanding the above traversal, Applicant submits that the original disclosure supports discussion and limitations directed to a wafer carrier misaligned over and with respect to the center of a pad. Referring, *e.g.*, to FIG. 2, a wafer carrier 130 (and corresponding wafer 135) is misaligned over a pad 140 with respect to the center of the pad. Furthermore, corresponding discussion in the specification, as filed, describes alignment of a wafer carrier misaligned with respect to the center of a pad and, further, misaligned relative to the wafer being polished in a center-offset manner (*see, e.g.*, page 9, line 16 through page 10, line 2). In this regard, the discussion and limitations upon which the Section 132 objection is based are supported in the specification and, therefore, the objection is further improper and should be removed.

Applicant respectfully traverses the Section 112 rejection because the rejection relies upon an improper premise in asserting that, because the term "misaligned" does not appear in the specification as originally filed, the claims fail to meet the written description requirement of Section 112(1). Applicant submits that this premise is insufficient for making a Section 112 rejection. The written description requirement of Section 112(1) does not require the applicant to describe exactly the subject matter claimed or that the specification provide word-for-word correspondence to the claims; instead, the test is whether the description allows persons of ordinary skill in the art to

recognize that he or she invented what is claimed. In this instance, the lack of a specific term “misaligned” in the original specification is thus an improper premise upon which to base the Section 112(1) rejection, and the rejection should therefore be removed.

Notwithstanding the impropriety of the Section 112(1) rejection, Applicant further submits that the Specification, as filed, provides support for positioning a wafer misaligned relative to a pad. Referring to FIG. 2 by way of example, the wafer carrier 130 is shown misaligned with the pad 140. Therefore, one of skill in the art would readily recognize that the Applicant contemplated the wafer carrier 130’s misalignment with the pad 140 in FIG. 2. In this regard, the specification meets the written description requirement and the Section 112(1) rejection is accordingly improper and should be reversed.

Applicant respectfully traverses the Section 102 and 103 rejections, all of which rely upon the ‘462 reference, because the Office Action has asserted an improper inherency type argument in making the rejections. To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter *is necessarily present in the thing described in the reference*, and that it would be so recognized by persons of ordinary skill.” *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991) (emphasis added). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* at 1269, 20 U.S.P.Q.2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981)). In this regard, a Section 102 or 103 rejection cannot properly rely upon an inherency argument failing to assert extrinsic evidence as discussed above.

In this instance, the ‘426 reference is more likely performing the common approach of conditioning a pad to address undesirable wafer polishing characteristics. Because the Office Action has failed to provide extrinsic evidence that makes clear that the asserted inherent subject matter is necessarily present in the ‘462 reference, such other possibilities (as to the true operation of the ‘482 embodiment) negate the plausibility of the rejection. For example, page 3 of the Office Action makes reference to various labeled items in the figures of the ‘462 reference in describing what are apparently asserted as inherent approaches. However, the Office Action failed to recite particular portions of the specification for teaching or suggestion of these assertions of

inherent subject matter. For instance, the Office Action asserts on page 3 that the '462 reference teaches several approaches including determining polishing conditions relating to center-offset polishing and center-slow polishing, among others. The Office Action fails, however, to show that these approaches are necessarily present in the '462 reference. Furthermore, Applicant has reviewed the '462 reference and can not find any mention of terms such as "center-offset" and others. The Applicant also can not find any teaching or suggestion for limitations directed to conditioning a pad as a function center-offset polishing or directed to positioning a wafer carrier as a function of the center-offset polishing. Each of the rejected claims is directed to limitations relating to such conditioning and wafer placement, relative to center-offset polishing. Therefore, the asserted inherency-type argument is improper and the Section 102 and 103 rejections should be removed.

Applicant further traverses the Section 102 and 103 rejections because the Office Action has failed to adequately show where the '462 reference teaches or suggests the claimed limitations as asserted in the Office Action in a manner consistent with 35 U.S.C. §132, thus denying the Applicant an opportunity to judge the propriety of the rejections and formulate a response. For instance, in rejecting the method claims, the Office Action mentions certain reference numerals, apparently from FIG. 1 in the '462 reference, but fails to mention any portion of the specification or any specific figure. In rejecting the apparatus claims, the Office Action mentions, on page 4, five of the seven figures in the '462 reference and nearly the entire Detailed Description, without reference to specific portions thereof. Applicant submits that this citation is insufficient for informing the Applicant as to the rationale behind the rejections, fails to afford the Applicant an opportunity to evaluate the rejections and adequately respond thereto and, further, fails to properly establish Section 102 or Section 103 rejections. In this regard, Applicant submits that the Section 102 and 103 rejections should be removed.

Applicant further traverses the Section 102 and 103 rejections because the Office Action failed to cite teaching or suggestion of various claimed limitations, including those directed to conditioning a pad and positioning a wafer carrier misaligned with a pad as a function of a wafer polishing in a center-offset condition. As discussed above, the Office Action has not shown where the cited references teach or suggest these limitations. Further, after brief review of the cited references, Applicant cannot ascertain any teaching

or suggestion of these and other claimed limitations. In this regard, the Section 102 and 103 rejections also fail to show correspondence between the cited references and the claims. Without such correspondence, the Section 102 and 103 rejections should be removed.

In view of the above, Applicant believes that the rejections have been overcome and the application is in condition for allowance. A favorable response is requested. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

CRAWFORD MAUNU PLLC
1270 Northland Drive, Suite 390
St. Paul, MN 55120
651/686-6633

Dated: November 2, 2004

By: 

Robert J. Crawford
Reg. No. 32,122
Eric J. Curtin
Reg. No. 47,511